

REMARKS-General

1. The newly drafted independent claim 13 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 13-24 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Response to Rejection of Claims 12 under 35USC103

2. The Examiner rejected claims 12 over Flynn (US. 6,543,450) in view of Chung (US 6,526,975) and further in view of Olson (US 5,206,956).

3. Pursuant to 35 U.S.C. 103: "(a) A patent may not be obtained thought the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

4. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

5. In other words, the differences between the subject matter sought to be patent **as a whole** of the instant invention and Flynn which is qualified as prior art of the instant invention under 35USC102(e) are obvious in view of Chung and Olson at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

6. The applicant respectfully submits that in order to determine whether the differences between the subject matters sought to be patent as a whole of the instant invention and the primary prior art, Flynn, are obvious in view of the supplemental cited arts, Chung and Olson, we have to identify all the differences between the claims of the instant inventions and Flynn. The applicant respectfully identifies the differences between the claims of the instant invention and Flynn as follows:

(a) in claim 13, "an eye protection film affixed to an upper periphery of the mask body" is claimed to substantially support the eye protection film at a position close to an upper facial area of the user, wherein Flynn merely discloses a mask body defining a visual portion and a respiratory portion that fails to suggest any eye protection film affixed to an upper periphery of the mask body.

In addition, the instant invention discloses the mask body can be any conventional mask to be worn by the user to cover the mouth and nose area of the user such that the instant invention minimizes the manufacturing cost of the mask by affixing the eye protection film to the upper periphery of the mask body. However, the mask of Flynn is made in one piece integral structure that the visual portion is integrally extended from the respiratory portion.

(b) in claim 13, "the eye protection film is made of flexible and twistable material and is adapted to be deformed" is claimed to allow the eye protection film to be deformed according to a facial contour of the user, wherein Flynn merely discloses the mask body is flexible that fails to re-shape the visual portion of the mask body with respect to the facial contour of the user. Flynn merely teaches the visual portion of the mask body is shaped as the goggles to airtight seal around the eyes of the user. The eye protection film of the instant invention is a transparent panel covering the upper facial area of the user. Therefore, the visual portion of the mask body of Flynn is not equivalent to the eye protection film of the instant invention. In other words, Flynn did not provide any of such suggestion or description in its disclosure that the eye protection film is deformed according to the facial contour of the user.

(c) in claim 13, "an adhesive band having a user adhesion side which is provided on a film periphery of the eye protection film" is claimed, wherein Flynn merely discloses, in column 7, lines 15-16, a seal 10 formed between upper visor portion 2 and

lower respiratory portion 3 of the mask 1 that fails to teach the adhesive provided on a film periphery of the eye protection film.

(d) in claim 13, "the adhesive band has a predetermined thickness adapted for placing on said user's face" is claimed to maintain the eye protection film with a predetermined distance away from the user with respect to the facial contour of the user and to seal the foreign objects, viruses or bacteria from the user's face. Flynn merely discloses, in column 7, lines 23-25, the seal 10 prevents any contaminants which may find its way into respiratory portion 3, from entering visual portion 2. It is apparent that **seal** is the main objective and achievement of Flynn since Flynn specifically emphasizes the seal is to gas-tight and liquid-tight between the upper visual portion 2 and the lower respiratory portion 3. In other words, the seal 10 of Flynn is not the same as the adhesive band of the instant invention. It is worth to mention that the adhesive band of the instant invention can achieve two different functions that Flynn cannot achieve. The adhesive band can (i) maintain the eye protection film with a predetermined distance away from the user with respect to the facial contour of the user, and (ii) seal the foreign objects, viruses or bacteria from the user's face.

(e) Flynn does not teach "the eye protection film is made of polypropylene" as claimed in claim 14 in addition to what is claimed in claim 13 as a whole.

(f) Flynn does not teach "a parting removably covering the user adhesion side" as claimed in claims 15 and 16 in addition to what is claimed in claim 13 as a whole.

(g) Flynn does not teach "the parting has a plurality of tear off lines that allows the parting to be selectively torn off for comfortably fitting the facial contour of the user" as claimed in claims 17 and 18 in addition to what is claimed in claim 13 as a whole.

(h) Flynn does not teach "two ear hanging straps for wearing at user's ears respectively so as to retain the mask body in position" as claimed in claims 19 and 21 in addition to what is claimed in claim 13 as a whole. Accordingly, Flynn merely teaches two Velcro straps 11 to hold the mask 1 in place. The applicant respectfully submits that the eye protection film is supported by the mask body when the mask body is worn via the two ear hanging straps. Therefore, the user does not need to directly wear the eye

protection film on the user's face while the adhesive band retains the eye protection film on the user's face in position.

(i) Flynn does not contain "a nose area adjusting piece formed at the upper periphery of the mask body" as claimed in claims 22 and 24 in addition to what is claimed in claim 13 as a whole. The nose adjusting piece of the instant invention is adapted to be deformed for fitting at the nose of said user according to a nose contour of the user so as to enforce the eye protection film to be deformed at the upper periphery of the mask body. In other words, the mask body is air-communicating with the eye protection film even the nose adjusting piece is bent to fit at the nose. However, the seal of Flynn gas-tight and liquid-tight between the upper visual portion 2 and the lower respiratory portion 3.

7. Whether the claims 13 to 24 of the instant invention are obvious depends on whether the above differences (a) to (i) between the instant invention and Flynn are obvious in view of Chung and Olson at the time of the invention was made.

8. Furthermore, the applicant respectfully submits that when applying 35 USC 103, the following tenets of patent law must be adhered to:

- (a) The claimed invention must be considered as a whole;
- (b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (c) The references must be viewed without the benefit of hindsight vision afforded by the claimed invention; and
- (d) Reasonable expectation of success is the standard with which obviousness is determined.

Also, "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." Libbey-Owens-Ford v. BOC Group, 4 USPQ 2d 1097, 1103 (DCNJ 1987).

9. Chung merely teaches a disposable gas mask having an eye protection window and a filter unit, wherein a peripheral adhesive band formed at an inner surface of the

body along a peripheral edge of the body while surrounding the eye protection window and the filter unit without any suggestion of how to maintain the eye protection film with a predetermined distance away from the user with respect to the facial contour of the user and to seal the foreign objects, viruses or bacteria from the user's face. Chung merely teaches, in column 4, lines 15-18, the adhesive band may include a first protective sheet for covering an upper portion of the adhesive band and a second protective sheet for covering the remaining, lower portion of the adhesive band. The applicant respectfully submits the parting of the instant invention is removably covering the user adhesion side wherein the parting has a plurality of tear off lines that allows the parting to be selectively torn off for comfortably fitting the facial contour of the user.

10. Olson merely suggests a transparent sheet material may be composed of polyethylene. Similarly, neither Flynn, Chung nor Olson suggests an eye protection film with mask structure containing the above distinctive features (a) to (i) as claimed in the instant invention as well as any combination or possibility of the eye protection film adapted to be deformed according to a facial contour of the user and the adhesive band adapted for placing on said user's face" is claimed to maintain the eye protection film with a predetermined distance away from the user with respect to the facial contour of the user and to seal the foreign objects, viruses or bacteria from the user's face.

11. "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited art references for combination in the manner claimed... [T]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness..." *In re Gorman*, 933 F.2d 982, 986, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991).

12. Accordingly, the applicant believes that neither Flynn, Chung nor Olson, separately or in combination, suggest or make any mention whatsoever of the difference subject features (a) to (i) as claimed in the amended claims 13 to 24 of the instant invention.

13. Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

The Cited but Non-Applied References

14. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

15. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection are requested. Allowance of claims 13-24 at an early date is solicited.

16. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Raymond Y. Chan
Reg. Nr.: 37,484
108 N. Ynez Ave.
Suite 128
Monterey Park, CA 91754
Tel.: 1-626-571-9812
Fax.: 1-626-571-9813

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 10/19/2005

Signature: 
Person Signing: Raymond Y. Chan